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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,908	11/30/2000	Scott Johnson	PALM-3216 . US .P	3695

7590 01/12/2005  
WAGNER, MURABITO & HAO LLP  
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San Jose, CA 95113

EXAMINER
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SHERKAT, AREZOO

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/727,908

Applicant(s)

JOHNSON ET AL.

Examiner

Arezoo Sherkat

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on August 3, 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Response to Amendment***

This office action is responsive to Applicant's amendment received on August 4, 2004. Claims 1-20 remain pending in the case.

***Response to Arguments***

Applicant's arguments filed on August 3, 2004 have been fully considered but they are not persuasive.

Applicant argues that Kikinis teaches disconnecting the proxy server from the hand-held unit to prevent unauthorized access to the proxy server and therefore teaches away from "preventing a user from accessing web clipping applications that are installed on said electronic device and located within said installed software".

Examiner argues and emphasizes that Kikinis discloses that if the logon, the proxy server disconnects from the hand-held unit (Col. 9, lines 7-65). In such cases, the proxy server gets disconnected from the hand-held unit to prevent transfer of the HT-Lite (HTL), the result of the assembly of all downloaded files from the web server to the proxy server (Col. 10, lines 5-45).

Applicant argues that "the key in Hurtado's disclosure is never intended to be used by the user. In fact, the purpose of the Hurtado key is to prevent access to the key altogether by the end user."

Examiner argues that in Hurtado's disclosure "the end user system receives a secure container containing the decrypting key for decrypting at least part of the previously encrypted content as permitted (Abstract).

Examiner respectfully maintains the rejection formulated on April 23, 2004.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis, (U.S. Patent No. 6,076,109 and Kikinis hereinafter), in view of Hurtado et al., (U.S. Patent No. 6,611,812 and Hurtado hereinafter).

Regarding claim 1, Kikinis discloses an electronic device having installed software therein for accessing a proxy server, a method comprising the steps of:

b) said user registering said electronic device with said proxy server using a registration application of said installed software (i.e., If the Log-On is valid, control passes to step 67, and the Proxy-Server acknowledges the successful log-on to the hand-held unit at step 69 )(Col. 9, lines 55-67); and

c) upon authorized registration of said electronic device with said proxy server, allowing said web clipping applications to be made available for use by said user and otherwise preventing access of said web clipping applications by said user (i.e., the service will become available to user's device after user logon)(Col. 9, lines 40-67 and Col. 10, lines 1-67).

Kikinis does not expressly disclose preventing a user from accessing web clipping applications that are installed on said electronic device and located within said installed software.

However, Hurtado discloses a) preventing a user from accessing web clipping applications that are installed on said electronic device and located within said installed software (i.e., preventing access to the encryption key by even the End-User(s) helps to prevent piracy or sharing of the Content 113 with other computers)(Col. 87, lines 10-67 and Col. 88, lines 1-67).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to modify the teachings of Kikinis with the teachings of Hurtado because it would allow to include preventing a user from accessing web clipping applications that are installed on said electronic device and located within said installed software with the motivation to establish a secure, global distribution system for digital content that protects the rights of content owners (Hurtado, Col. 1, lines 55-65).

Regarding claim 2, Kikinis discloses wherein said electronic device is a personal information device (PID) comprising handheld organizers, cellular phones, laptop computers, and pagers (Col. 4, lines 45-67 and Col. 5, lines 1-8).

Regarding claim 3, Kikinis does not expressly disclose preventing a user from accessing web clipping applications implemented by said electronic device.

However, Hurtado discloses wherein said step a) of preventing a user from accessing web clipping applications implemented by said electronic device is comprised of:

preventing a user from accessing web clipping applications that are installed on said electronic device and located within said installed software by hiding said web clipping applications within said installed software until such time that said device is registered with said proxy server (i.e., preventing access to this key by even the End-User(s) helps to prevent piracy or sharing of the Content 113 with other computers meaning that only authorized users may execute the program)(Col. 87, lines 10-67).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to modify the teachings of Kikinis with the teachings of Hurtado because it would allow to include preventing a user from accessing web clipping applications that are installed on said electronic device and located within said installed software with the motivation to establish a secure, global distribution system for digital content that protects the rights of content owners (Hurtado, Col. 1, lines 55-65).

Regarding claim 4, Kikinis discloses wherein said step c) of allowing said web clipping applications to be made available is comprised of:

upon authorized registration of said electronic device with said proxy server, revealing said web clipping applications to said user and otherwise preventing access of said web clipping applications by said user (i.e., the service will become available to user's device after user logon)(Col. 9, lines 40-67 and Col. 10, lines 1-67).

Regarding claim 5, Kikinis discloses further comprising the step of

d) said user implements at least one of said web clipping applications to access and retrieve information from a web-site via said proxy server (Col. 5, lines 8-67 and Col. 6, lines 1-67 and Col. 7, lines 1-67 and Col. 8, lines 1-53).

Regarding claim 6, Kikinis discloses wherein said step d) of said user implements at least one of said web clipping applications to access and retrieve information is comprised of steps:

d1) said user implements at least one of said web clipping applications, d2) said at least one web clipping application commands a browser application within said installed software to seek web-site data associated with said at least one web clipping application, d3) said browser accesses said proxy server and requests clipped data from said web-site associated with said at least one web clipping application, and d4) said electronic device receives said clipped data requested by said browser from said proxy server (Col. 5, lines 8-67 and Col. 6, lines 1-67 and Col. 7, lines 1-67 and Col. 8, lines 1-53).

Regarding claim 7, Kikinis does not expressly disclose wherein said step d) of said user implements at least one of said web clipping applications to access and retrieve information is performed without registration of said electronic device during said access and without a transfer of user authorization information.

However, Hurtado discloses wherein said step d) of said user implements at least one of said web clipping applications to access and retrieve information is performed without registration of said electronic device during said access and without a transfer of user authorization information (Col. 76, lines 29-55).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to modify the teachings of Kikinis with the teachings of Hurtado because it would allow to include preventing a user from accessing web clipping applications that are installed on said electronic device and located within said installed software with the motivation to establish a secure, global distribution system for digital content that protects the rights of content owners (Hurtado, Col. 1, lines 55-65).

Regarding claim 8, Kikinis does not expressly disclose wherein said installed software upon said electronic device is a result of a step preceding said step a) of preventing a user from accessing web clipping applications, said step preceding comprising: downloading said software from said proxy server onto said electronic device.

However, Hurtado discloses wherein said installed software upon said electronic device is a result of a step preceding step a) of preventing a user from accessing web clipping applications, comprising the step of: downloading said software from said proxy server onto said electronic device (Col. 25, lines 42-67 and Col. 26, lines 1-6 and Col. 27, lines 1-25).



Therefore, it would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to modify the teachings of Kikinis with the teachings of Hurtado because it would allow to include downloading said software from said proxy server onto said electronic device preceding preventing a user from accessing web clipping applications with the motivation to establish a secure, global distribution system for digital content that protects the rights of content owners (Hurtado, Col. 1, lines 55-65).

Regarding claim 9, Kikinis discloses a method for secure access of a proxy server by a portable information device (PID) wherein recurring device identification is eliminated, comprising the steps of:

c) upon said registering said PID, commanding said PID to reveal said web clipping applications, d) initiating a browser command for clipped data from said PID, wherein said initiating is a result of the activation by said user of at least one of said revealed web clipping applications, and e) transmitting said clipped data to said PID (Col. 7, lines 11-67, Col. 8, lines 1-67).

Kikinis does not expressly disclose wherein the software package comprises a registration application and multiple hidden web clipping applications.

However, Hurtado discloses wherein

a) loading a software package onto said PID wherein said software package comprises a registration application and multiple hidden web clipping applications (Col. 87, lines 10-67); and

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b) registering said PID by the implementation of said registration application by a user (Col. 24, lines 46-60).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to modify the teachings of Kikinis with the teachings of Hurtado because it would allow to include downloading said software from said proxy server onto said electronic device preceding preventing a user from accessing web clipping applications with the motivation to establish a secure, global distribution system for digital content that protects the rights of content owners (Hurtado, Col. 1, lines 55-65).

Regarding claim 10, Kikinis discloses further comprising the steps of:

d1) accessing data on a web-site corresponding to said at least one of said revealed web clipping applications, and d2) clipping content on said web-site to create clipped data acceptable to said PID (Col. 8, lines 1-67 and Col. 9, lines 1-67 and Col. 10, lines 1-67).

Regarding claim 11, Kikinis discloses wherein said step a) of loading a software package onto said PID is comprised of the step of: downloading a software package from said proxy server via the Internet onto said PID (Col. 6, lines 15-67).

Regarding claim 12, Kikinis discloses wherein Proxy-Server 19 accesses the appropriate server (in this case server 23) over link 21, and downloads the appropriate

data over link 21. Proxy-Server 19 therefore has HTML and TCP/IP capability, and typically has access to and capability of executing a host of other routines as known in the art for supporting WEB browsing and accessing data through the World Wide Web. These routines and this functionality are all very well-known to those with skill in the art. Proxy-Server 19, instead of displaying the downloaded data (or playing video and/or audio output, as the case may be, depending on the downloaded data), translates the data to a simpler communication protocol and sends the data to computer 13 for output over link 15 in a TCP/IP protocol. Link 15 becomes a dedicated TCP/IP pipe to and from Proxy-Server 19. Proxy-Server 19 thus acts as a proxy for computer 13, performing those functions of WEB browsing computer 13 cannot perform (Col. 6, lines 23-65).

Kikinis does not expressly disclose wherein said step of loading a software package onto said PID is without cost to said user and without restriction to the acquirement of said software package by said user.

However, Hurtado discloses wherein said step of loading a software package onto said PID is without cost to said user and without restriction to the acquirement of said software package by said user (Col. 76, lines 33-55).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to modify the teachings of Kikinis with the teachings of Hurtado because it would allow to include downloading said software from said proxy server onto said electronic device preceding preventing a user from accessing web clipping applications with the motivation to establish a secure, global distribution system

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for digital content that protects the rights of content owners (Hurtado, Col. 1, lines 55-65).

Regarding claim 13, Kikinis discloses wherein Proxy-Server 19 accesses the appropriate server (in this case server 23) over link 21, and downloads the appropriate data over link 21. Proxy-Server 19 therefore has HTML and TCP/IP capability, and typically has access to and capability of executing a host of other routines as known in the art for supporting WEB browsing and accessing data through the World Wide Web. These routines and this functionality are all very well-known to those with skill in the art. Proxy-Server 19, instead of displaying the downloaded data (or playing video and/or audio output, as the case may be, depending on the downloaded data), translates the data to a simpler communication protocol and sends the data to computer 13 for output over link 15 in a TCP/IP protocol. Link 15 becomes a dedicated TCP/IP pipe to and from Proxy-Server 19. Proxy-Server 19 thus acts as a proxy for computer 13, performing those functions of WEB browsing computer 13 cannot perform (Col. 6, lines 23-65).

Kikinis does not expressly disclose wherein said web clipping applications allow a user of said PID to access data and services on a proxy server without cost to said user and without registration of said user during said access of data and services.

However, Hurtado discloses wherein said web clipping applications allow a user of said PID to access data and services on a proxy server without cost to said user and

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without registration of said user during said access of data and services (Col. 76, lines 33-55).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to modify the teachings of Kikinis with the teachings of Hurtado because it would allow to include downloading said software from said proxy server onto said electronic device preceding preventing a user from accessing web clipping applications with the motivation to establish a secure, global distribution system for digital content that protects the rights of content owners (Hurtado, Col. 1, lines 55-65).

Regarding claim 14, Kikinis does not expressly disclose wherein said web clipping applications are hidden inside said registration application.

However, Hurtado discloses wherein said web clipping applications are hidden inside said registration application (Col. 10, lines 30-65).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to modify the teachings of Kikinis with the teachings of Hurtado because it would allow to include wherein said web clipping applications are hidden inside said registration application with the motivation to establish a secure, global distribution system for digital content that protects the rights of content owners (Hurtado, Col. 1, lines 55-65).

Regarding claim 15, Kikinis discloses a system comprising: a proxy server coupled to the Internet (Col. 2, lines 54-67); and

an electronic device comprising a processor coupled to a bus and a memory coupled to said bus, said memory having installed software for accessing said proxy server and having stored therein instructions (Col. 5, lines 26-67 and Col. 6, lines 1-16) for implementing a method comprising the steps of:

b) said user registering said electronic device with said proxy server using a registration application of said installed software (i.e., If the Log-On is valid, control passes to step 67, and the Proxy-Server acknowledges the successful log-on to the hand-held unit at step 69 )(Col. 9, lines 55-67); and

c) upon authorized registration of said electronic device with said proxy server, allowing said web clipping applications to be made available for use by said user and otherwise preventing access of said web clipping applications by said user (i.e., the service will become available to user's device after user logon)(Col. 9, lines 40-67 and Col. 10, lines 1-67).

Kikinis does not expressly disclose preventing a user from accessing web clipping applications that are installed on said electronic device and located within said installed software.

However, Hurtado discloses a) preventing a user from accessing web clipping applications that are installed on said electronic device and located within said installed software (i.e., preventing access to the encryption key by even the End-User(s) helps

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to prevent piracy or sharing of the Content 113 with other computers)(Col. 87, lines 10-67 and Col. 88, lines 1-67).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to modify the teachings of Kikinis with the teachings of Hurtado because it would allow to include preventing a user from accessing web clipping applications that are installed on said electronic device and located within said installed software with the motivation to establish a secure, global distribution system for digital content that protects the rights of content owners (Hurtado, Col. 1, lines 55-65).

Regarding claim 16, Kikinis discloses wherein said electronic device is a personal information device (PID) comprising handheld organizers, cellular phones, laptop computers, and pagers (Col. 4, lines 45-67 and Col. 5, lines 1-8).

Regarding claim 17, Kikinis does not expressly disclose preventing a user from accessing web clipping applications implemented by said electronic device.

However, Hurtado discloses wherein said step a) of preventing a user from accessing web clipping applications implemented by said electronic device is comprised of:

preventing a user from accessing web clipping applications that are installed on said electronic device and located within said installed software by hiding said web clipping applications within said installed software until such time that said device is

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registered with said proxy server (i.e., preventing access to this key by even the End-User(s) helps to prevent piracy or sharing of the Content 113 with other computers meaning that only authorized users may execute the program)(Col. 87, lines 10-67).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to modify the teachings of Kikinis with the teachings of Hurtado because it would allow to include preventing a user from accessing web clipping applications that are installed on said electronic device and located within said installed software with the motivation to establish a secure, global distribution system for digital content that protects the rights of content owners (Hurtado, Col. 1, lines 55-65).

Regarding claim 18, Kikinis discloses wherein said step c) of allowing said web clipping applications to be made available is comprised of:

upon authorized registration of said electronic device with said proxy server, revealing said web clipping applications to said user and otherwise preventing access of said web clipping applications by said user (i.e., the service will become available to user's device after user logon)(Col. 9, lines 40-67 and Col. 10, lines 1-67).

Regarding claim 19, Kikinis discloses wherein said method implemented by said electronic device further comprises the step of: d) said user implements at least one of said web clipping applications to access and retrieve information from a web-site via



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said proxy server (Col. 5, lines 8-67 and Col. 6, lines 1-67 and Col. 7, lines 1-67 and Col. 8, lines 1-53).

Regarding claim 20, Kikinis does not expressly disclose wherein said installed software upon said electronic device is a result of a step preceding step a) of preventing a user from accessing web clipping applications, comprising the step of: downloading said software from said proxy server onto said electronic device.

However, Hurtado discloses wherein said installed software upon said electronic device is a result of a step preceding step a) of preventing a user from accessing web clipping applications, comprising the step of: downloading said software from said proxy server onto said electronic device (Col. 25, lines 42-67 and Col. 26, lines 1-6 and Col. 27, lines 1-25).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to modify the teachings of Kikinis with the teachings of Hurtado because it would allow to include downloading said software from said proxy server onto said electronic device preceding preventing a user from accessing web clipping applications with the motivation to establish a secure, global distribution system for digital content that protects the rights of content owners (Hurtado, Col. 1, lines 55-65).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arezoo Sherkat whose telephone number is (571) 272-3796. The examiner can normally be reached on 8:00-4:30 Monday-Friday.

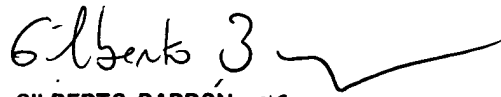
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Arezoo Sherkat  
Patent Examiner  
Group 2131  
Jan 10, 2005



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